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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,329	04/21/1999	YASUMASA KAWABE	Q54114	7050

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EXAMINER

THORNTON, YVETTE C

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 01/09/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/295,329

Applicant(s)

KAWABE ET AL.

Examiner

Yvette C. Thornton

Art Unit

1752

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 10 July 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 16-26.

Claim(s) objected to: _____.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. Does NOT place the application in condition for allowance because: the amendment to the instant claims was successful in making the declaration material presented in paper numbers 20 and 29 commensurate in scope with the claimed invention. The said declaration data however is not convincing.

Applicants evaluate comparative data by two distinct parameters: (1) residual film rate and (2) profile. The numbers presented in the inventive examples for residual film rate are 99.3% and 99.6%. The numbers presented for the comparative examples are 94.6% and 95.2%. Applicants argue that the difference in the inventive examples and the comparative examples presents an extremely large difference in the art and is considered to be an unexpected result to one of ordinary skill in the art. The applicant however has provided no evidence that such a difference is indeed substantial. In re Klosak (173 USPQ 14) has established that, "it is not enough to show that results are obtained which differ from those obtained in the prior art: that difference must be shown to be an unexpected difference." See also In re Freeman (177 USPQ 139). Applicants merely state on the record that the results are unexpected. There is no evidence which shows that the difference in residual rates for the inventive and comparable examples to be substantial and unexpected to one of ordinary skill.

In regard to profile, applicants provide two definitions. Profile A, which is a rectangular pattern, and profile B, which is anything other than rectangular. Applicants further define profile A to have an angle of 85-90 between the substrate and the sidewall, wherein 88-89 is particularly preferred. Profile B has an angle of 80-85. The angles presented for the inventive examples are 89 and 88. The angles presented for the comparative examples are 85 and 86. The examiner is unclear as to why the comparative examples are labeled as profile B, when the angles are clearly within the range of profile A.

The examiner maintains that there is no evidence of unexpected results. The proposed amendment has been entered. However, the rejection of claims 1-15 over Suwa is maintained.

The amendments to claims 23-25 are sufficient to overcome the claim objections of record. The said claims are ^{now} ~~not~~ deemed to be allowable.

Any questions and/or comments can be directed to Examiner Yvette Clarke Thornton at 703-305-0589.

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